

## **REMARKS/ARGUMENTS**

Claims 8, 10, 12, 13 and 15-20 are pending in the present application, of which claims 8, 15 and 20 are independent claims. Claims 1-7, 9, 11, 14 and 21-30 have been canceled without prejudice or disclaimer. Claims 8, 10, 13, 15, 17 and 20 have been amended by this Amendment.

### **Claim Rejections under 35 USC § 103**

Claims 8-13 and 20-26 stand rejected under 35 USC § 103(a) as unpatentable over Shieh et al. (U.S. Pat. No. 6,591,098, hereinafter “Shieh”) in view of MCI Communications Corporation (WO 97/01253, hereinafter “MCI”). Claim 15 stands rejected under 35 USC § 103(a) as unpatentable over Shieh in view of Shannon et al. (U.S. Pat. No. 6,285,869, hereinafter “Shannon”). Claims 16-18 stand rejected under 35 USC § 103(a) as unpatentable over Shieh and Shannon in view of MCI. Claim 19 stands rejected under 35 USC § 103(a) as unpatentable over Shieh in view of Shannon and Borngraber (U.S. Pub. No. 2004/0120552, hereinafter “Borngraber”). Claims 28-30 stand rejected under 35 USC § 103(a) as unpatentable over Shieh in view of MCI and Borngraber.

### **Summary of subject matter disclosed in the specification**

The following descriptive details are based on the specification. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations, which are unclaimed.

Applicants’ disclosed embodiments are directed to a remote SIM card activation process when, for example, an old SIM card is being replaced by a new SIM card that can handle different and/or additional services for a particular subscriber. The old account is to be deactivated in favor of the new account being activated.

The old SIM card contains account information for the old account, such as the account identifier, which is prestored in a remote system. (See paragraph 34 of the published version of the present application US 2007/0167101). The new SIM card contains account information for the new account, such as a one-time account identifier (i.e., one-time IMSI), designed for a one-time logon to the network, and a new permanent account identifier (i.e., new IMSI) intended to replace the old account identifier. (See paragraphs 34-36 of the published application). The one-time and permanent account identifier for the new SIM card are prestored in a remote system. (See paragraph 28 of the published application).

The existing account information is copied from the old SIM card to the new SIM card by a suitable copying device. (See paragraphs 39-43 of the published application). The new SIM Card authenticates itself with the network using the one-time account identifier. (See paragraph 58 of the published application). Upon successful logon to the network using the one-time account identifier, an Auto-Activation application in the new SIM card sends out an Activation Request to the network. (See paragraph 59 of the published application). The application sends information that includes: the old account identifier copied from the old SIM card and the new permanent account identifier that is to be enabled. (See paragraphs 60-61 of the published application).

Upon successful sending of the Activation Request, the following operation occurs within the new SIM card. The Auto-Activation application exchanges the one-time account identifier with the permanent account identifier. (See paragraph 62 of the published application). Accordingly, the new SIM card automatically activates itself and exchanges the permanent parameter in place of the one-time parameter upon successful logon to the network. This is accomplished without receiving the permanent account identifier or other any instruction from

the network. Moreover, it is done by activating the new account information on the network “just-in-time”, and not earlier, to thereby make efficient use of network resources only when they are actually needed, i.e. only upon the new account being activated for the new SIM card.

Accordingly, Applicants’ disclosed embodiments are not required to provision all the account information into various network systems before activation. The activation will instead be done in a “just-in-time” fashion which greatly saves space on the network, and the use of the one-time account identifier thus eases the number of activated subscriptions required to be stored by the network. Moreover, Applicants’ disclosed embodiments use the same one-time account identifier for every account. That is, for a plurality of different new SIM cards intended for use on the network, each of the new SIM cards uses the same one-time account identifier.

Furthermore, a user can keep the same data and settings from a previous SIM card when the user changes to a new SIM card.

### Arguments

The art cited by the Examiner fails to teach or suggest a first subscriber identifying module comprising:

- 1) a one-time account identifier designed for a one-time logon to the network;
- 2) a permanent account identifier, said permanent account identifier being deactivated and attached to the first subscriber identifying module; and
- 3) another permanent account identifier, said another permanent account identifier being activated and attached to a second subscriber identifying module, wherein the another permanent account identifier is copied from the second subscriber identifying module to the first subscriber identifying module,

and the first subscriber identifying module programmed to “upon successful logon to the network, send an activation request including the permanent account identifier and the another permanent account identifier to said at least one remote network for deactivating in said at least one remote network the another permanent account identifier attached to the second subscriber identifying module”, as now expressly required by Applicants’ amended claim 8.

Shieh discloses a system and a method for activating a subscriber identification module (SIM) based mobile device in a PCS/ANSI type wireless network. The method of Shieh includes preprogramming the SIM card of the mobile device with temporary activation identifiers, such as an international mobile station identity (IMSI) and/or a mobile identification number (MIN), and a temporary electronic serial number (ESN). The temporary ESN, rather than the mobile device actual ESN, is used to identify the mobile device during registration and activation. The network identifies the temporary ESN associated with the SIM vendor and invokes an over-the-air activation procedure especially for the SIM card mobile devices. A SIM-over-the-air-activation processor is notified to perform the activation for that mobile device on the PCS wireless network. Authentication of the mobile device may be bypassed and the mobile device is instructed to transmit its actual electronic serial number for future registrations (See Abstract of Shieh). More specifically, Shieh explains at col. 7, lines 3-6 that “After activation, the network instructs (214) the mobile device to transmit the actual electronic serial number (ESN) for future registrations. This is accomplished by setting the usage indicator [in the SIM] to send the actual ESN in the future.” Shieh then further teaches in the following step 216 that the method finally comprises overwriting the temporary network activation identifiers so that the actual electronic serial number of the mobile device is not reported to the network until the over-the-air activation is completed.

Shieh, however, never copies another actual electronic serial number that is activated and attached to a second SIM to the SIM to be activated. Indeed, Shieh fails to identify or delineate any serial numbers other than the temporary electronic serial number and the actual electronic serial number that are stored in the SIM to be activated. It follows therefore that Shieh also fails to teach or suggest that the SIM to be activated sends an activation request including another actual electronic serial number that is activated and attached to a second SIM to said at least one remote network for deactivating in the at least one remote network the another actual electronic serial number that is attached to the second SIM.

MCI discloses a personal servicing communication network 10 that is configured to allow a subscriber to use a replacement SIM card 16 by merely inserting the replacement SIM card 16 into one of a plurality of network communication terminals 12 with the network automatically disabling the old SIM card 16p and enabling the replacement SIM card 16 for subsequent use. Upon first use of the replacement SIM card, the network disables the original identifier in the Home Location Register (HLR) 20 and in the Authentication Center (AuC) 22 so that subsequent access to the network by the subscriber is available solely by use of the replacement SIM card. (See the Abstract and Fig. 1 of MCI).

MCI, however, never copies the original identifier from the old SIM card 16p to the new SIM card 16. On the contrary, MCI discloses at page 8, lines 18-28 “The Authorization Center 22 is also configured to similarly correlate the previous IMSI identifier with the replacement ISMI identifier. The old and replacement ISMI identifiers allow access to the Authentication Center 22 and correspond with respective authentication keys stored therein. Upon such first use of the replacement SIM card 16, the previous or old IMSI identifier contained in both the register 20 and the Authentication Center 22 are disabled to prevent further access to the network by the

old SIM card 16p.” MCI therefore discloses correlating the previous IMSI with the replacement ISMI in the AuC 22 and HLR 20 in order to provide for deactivation of the old IMSI with activation of the new IMSI. MCI does not send an activation request including the old IMSI to the AuC 22 and/or the HLR 20 for deactivating therein the old IMSI attached to the old SIM card 16p.

Even assuming, *arguendo*, the propriety of the Examiner’s proffered combination of Shieh and MCI (which Applicants do not concede), such a combination at best teaches correlating an old ESN of an old SIM with the actual ESN in the AuC and/or HLR of Shieh. The skilled artisan therefore has no reason to “send an activation request including the permanent account identifier and the another permanent account identifier to said at least one remote network” as claimed by Applicants because the correlation in the AuC and/or HLR would be used determine the old or previous IMSI/ESN to be deactivated. The combination of Shieh and MCI, whether considered alone or in combination, thus fails to teach or suggest “another permanent account identifier, said another permanent account identifier being activated and attached to a second subscriber identifying module, wherein the another permanent account identifier is copied from the second subscriber identifying module to the first subscriber identifying module” and the first subscriber identifying module programmed to “upon successful logon to the network, send an activation request including the permanent account identifier and the another permanent account identifier to said at least one remote network for deactivating in said at least one remote network the another permanent account identifier attached to the second subscriber identifying module”, as now expressly required by Applicants’ amended claim 8.

Accordingly, claim 8 is deemed to be patentable over Shieh and MCI

The other cited references, Shannon and Borngraber, were cited by the Examiner as purportedly disclosing the features of dependent claims. However, nothing has been found in Shannon and Borngraber that would remedy the deficiencies of Shieh and MCI with respect to the features of claim 8 discussed above.

Independent claim 20, as amended, recites features similar to claim 8 and is therefore also deemed to be patentable over the applied prior art for reasons discussed above with respect to claim 8.

Independent claim 15 has been amended to recite features similar to those discussed above with respect to claim 8. Claim 15 stands rejected under 35 USC § 103(a) as unpatentable over Shieh in view of Shannon. However, as noted above, Shannon fails to cure the deficiencies of Shieh and MCI discussed above with respect to claim 8.

Shannon is related to replacing a SIM in a mobile communication network. Shannon provides a mapping between a new identity code and a corresponding existing identity code in a remote network so that the new identity code is associated with the corresponding subscriber details and is activated while the existing code is deactivated. (See Abstract of Shannon). Shannon therefore never stores both the new identity code and the existing identity code in the same SIM and, thus, does not send an activation request including both the new identity code and the existing identity code to the remote network from the SIM. The art cited by the Examiner accordingly fails to teach or suggest “a set of instructions for accepting logon of the first subscriber identifying module in the network with the one-time account identifier and treating an activation request including the permanent account identifier and another account identifier, which is deactivated and attached to the first subscriber identifying module, sent from an auto-activation application executed

in the first subscriber identifying module by the following operations”, as now expressly recited by Applicants’ independent claim 15.

Claims 10, 12, 13 and 16-19, which each depend from one of independent claims 8 or 15, distinguish the invention over the applied prior art for reasons discussed above in regard to the independent claims as well as on their own merits.

### **Conclusion**

Based on all of the above, the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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